

## REMARKS

Claims 34, 37, and 114 - 115 have been amended. Claim 116 has been added. No new matter has been introduced with these amendments or added claim, all of which are supported in the specification as originally filed. Claims 1, 9, 11, 14 - 15, 17 - 18, 20 - 24, 28, 34, 37, 90, and 99 - 116 are now in the application.

### I. First Rejection Under 35 U. S. C. §103(a)

Paragraph 5 of the Office Action dated February 8, 2007 (hereinafter, "the Office Action") states that Claims 1, 9, 15, 17 - 18, 20, 22, 28, 34, 37, 99 - 102, 105 - 109, and 111 - 115 are rejected under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent 5,943,402 to Hamel et al. (hereinafter, "Hamel") in view of U. S. Patent 6,975,988 B1 to Roth. This rejection is respectfully traversed.

Referring first to independent Claim 1, the Office Action admits that "Hamel does not specifically teach that one of the actions performed on a voicemail segment is associating a background sound". Office Action, p. 3, lines 14 - 15. The Office Action then continues by stating that it would have been obvious to modify Hamel to include teachings from Roth, and in particular, "to allow the user to select an action to associate the same or different background sounds to different voicemail segments ...". Office Action, p. 3, line 16 - p. 4, line 3.

Applicants respectfully submit that Hamel has no discussion, nor any suggestion, of background sound for a message (as admitted in the Office Action on p. 3, lines 14 - 15).

Furthermore, the “actions” taught by Hamel are of a different nature, and include such things as replaying a message segment, forwarding a message segment, deleting a message segment, skipping playback of a message segment, or partitioning a message segment into smaller segments (Hamel, col. 1, line 64 - col. 2, line 2). Hamel’s discussion of recording a message (col. 3, line 12 - 21) does not suggest, in any way, that background sound would be added to a message that is being recorded.

Hamel discusses setting “acoustic bullets” to mark a segment (col. 3, lines 36 - 55), and processing an encountered acoustic bullet (col. 3, line 56 - col. 4, line 7), as the first and second (respectively) of six options for processing interrupts (where such interrupts are signaled by the acoustic bullets; see col. 2, lines 17 - 19). In the discussion of the first option (i.e., setting acoustic bullets), Hamel states that the acoustic bullet is inserted into the message (see col. 3, lines 45 - 47) and processing then continues at step **85** (col. 3, lines 52 - 53). Step **85** represents presenting a menu to the subscriber to ask what should be done next (see **Fig. 2C**), and none of the choices discussed with reference to step **85** (see, for example, the text in **Fig. 2C** and in col. 4, lines 57 - 67) pertains to adding background sound for a message segment. In the discussion of the second option (i.e., encountering acoustic bullets), Hamel states that this encountered acoustic bullet is marked or flagged as the “current” acoustic bullet (col. 4, lines 3 - 4).

The third and fourth of the six options pertain to ending the message (col. 4, lines 8 - 14) and presenting or suppressing the above-discussed menu (col. 4, lines 15 - 25), neither of which teaches or suggests adding background sound. The fifth of the six options pertains to playing

back a recorded message (col. 4, lines 26 - 30), and discusses playing back the “voice” message that was already recorded. The sixth of the six options pertains to termination of recording (col. 4, lines 31 - 40). Again, neither the fifth or sixth option teaches or suggests adding background sound.

It is well settled that the claim language of Applicants’ claims cannot be used as a template to search through the prior art, looking for teachings that can be combined piecemeal in an attempt to render the claims obvious. See, for example, *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 USPQ 303, 312–13 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984), which held

To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

See also *In re Frisch*, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992), which held

It is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that “[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” (quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988)).

Accordingly, Applicants respectfully submit that one of skill in the art would not, in fact, be motivated to attempt a combination of Hamel with Roth, absent the prohibited hindsight reconstruction approach which is deemed impermissible according to *W.L. Gore & Associates* and *In re Frisch*.

Furthermore, Applicants respectfully submit that a combination of Hamel with Roth (assuming, *arguendo*, that such combination could be made and that one of skill in the art was motivated to attempt it) would fail to teach all limitations of their claimed invention as recited in independent Claim 1, as will now be discussed.

Roth's teachings pertain to electronic mail. See, for example, the Title of the invention ("Electronic mail method and system ...") and the first sentence of the Abstract ("A multi-mail system and method in which a sender may convey and a recipient can realize ... by receiving a message that is more than textual in nature", emphasis added; this is also repeated in the Summary of the Invention at col. 1, line 66 - col. 2, line 3). See also the Field of the Invention, stating "The invention relates to electronic mail methods and system ..." (col. 1, lines 9 - 10, emphasis added). Col. 4, lines 8 - 9 state "Senders **124** can input email message information in various ways." (emphasis added). A number of other such references to email messages may be found.

Roth defines what he means by the term "multi-mail message" at col. 3, lines 15 - 17, stating "A multi-mail message is an email message which has a multimedia component associated with the inputted message." (emphasis added).

Turning now to the discussion of Claim 1 in the Office Action, the cited text from col. 6, lines 22 - 56 of Roth indicates that the user chooses background sounds as part of changing his or her "personal options" (col. 6, lines 46 - 54). This text corresponds to **Fig. 3**, where the step **2113.4** "To choose other background sounds, press 4" is encountered after determining that the

user has selected step **2113** “To change your personal options press 3”. By contrast, if the user has selected step **2112** “To create a new multi-mail, press 2”, then step **2113.4** which pertains to background sounds is not reached. See also col. 6, lines 51 - 54, referring to choosing background sounds as “[a]dditional personal settings” (i.e., personal options corresponding to selection of step **2113**).

The cited text from col. 8, line 45 - col. 9, line 3 of Roth pertains to sound effects, stating “... a user may also wish to apply sound effects to a multi-mail message” (col. 8, lines 46 - 47) and “These sound effects enable a user to include ... sound that is associated with a multi-mail message” (col. 8, lines 47 - 49). However, Applicants respectfully submit that discussions of these sound effects are in the singular. See the following described embodiments:

- col. 8, lines 49 - 50, “In one embodiment, the sound effect ...” (emphasis added);
- col. 8, line 52, “In another embodiment, the sound effect ...” (emphasis added);
- col. 8, lines 54 - 55, “In yet another embodiment, the sound ...” (emphasis added);  
and
- col. 8, line 56, “Finally, in another embodiment, the sound effect ...” (emphasis added).

While col. 8, line 60 states “including background music”, Applicants find no discussion nor any suggestion that plural background sounds might be included in a voice mail message, in contrast to the limitations specified in Applicants’ Claim 1.

The cited text from col. 9, line 58 - col. 10, line 48 of Roth discusses **Figs. 11 - 12** and pertains to creating a new message. Applicants respectfully note that col. 9, lines 60 - 61 state “This is accomplished by (1) creating an audio portion ...” (emphasis added). That is, this statement from Roth teaches creation of a single audio portion for a new multi-mail message.

See also col. 10, lines 2 - 5, referring to “an otherwise standard text email” (emphasis added). In other words, as discussed earlier, Roth’s teachings pertain to email messages.

A looping process is shown in **Fig. 11**, which pertains to creating a new multi-mail. However, review of the corresponding text fails to indicate that Roth perceived adding more than one background sound to a message via this looping process. See col. 10, lines 10 - 13, which show that the looping is for a user who “does not approve the message” he or she has just created, and stating that the return to step **1112.1** is so that the just-created message “may be edited or created anew in part or in toto”. By contrast, if the user does approve the just-created message, then the looping process is not encountered; instead, processing continues to step **1112.7**, where the message is transmitted (col. 10, lines 13 - 16).

Col. 10, lines 25 - 29 also refer to creating “an” audio component or “the” audio component of a multi-mail message. In one embodiment, this audio component is provided by the user “enter[ing] text via user interface device **120**” (col. 10, lines 31 - 32). In an alternate embodiment, the audio component is provided by the user “submit[ting] a spoken message by telephone” (col. 10, lines 39 - 40), where “Next, central controller translates the sound [i.e., the

spoken message] to text ...” (col. 10, lines 43 - 44). (See also **Fig. 12**, where these 2 embodiments are illustrated.) Applicants respectfully submit that this text is discussing the voice message itself, and there is no discussion, or any suggestion, that this text from Roth pertains to the background sound.

The cited text from col. 12, lines 14 - 43 of Roth discusses **Fig. 16**. Applicants respectfully note that **Fig. 16** is an expansion of detail corresponding to step **1112.12** of **Fig. 12**. See the “Submit spoken message by telephone” box of **Fig. 12**, which is labeled with step number **1112.12**, and the matching box and step number at the beginning of **Fig. 16**. Accordingly, **Fig. 16** explains in further detail how the user speaks an audio component that is going to be converted to text (see step **1112.121** of **Fig. 12** and corresponding text in col. 10, lines 39 - 45). Accordingly, col. 12, lines 21 - 43 explain that this user accesses the system by calling a telephone number (col. 12, lines 21 - 22; see also step **1112.121** of **Fig. 16**), and then proceeds to record “a voice sample” (col. 12, lines 25 - 26); see also col. 12, lines 30 (“the voice sample is recorded”) and 34 (“record the user’s voice sample”). Accordingly, Applicants respectfully submit that this text from col. 12, lines 14 - 43 is not pertinent to the claim language of Claim 1, as it is discussing the voice message itself, and creating text from sound, and is not discussing a background sound.

In view of the above, Applicants respectfully submit that Hamel and/or Roth fail to teach, or suggest, all of the limitations specified in independent Claim 1. Claim 1 is therefore deemed patentable over these references. Independent Claim 100 (discussed in the Office Action on p. 5, line 21 - p. 6, line 2) and independent Claim 111 (discussed in the Office Action on p. 6, lines 10 -

15) specify limitations which are analogous to those of Claim 1, and Claims 100 and 111 are therefore deemed patentable over the references by virtue of the same arguments presented with regard to Claim 1. Dependent Claims 9, 15, 17 - 18, 20, 22, 28, 99, 101 - 102, 105 - 109, and 112 - 113 are therefore deemed patentable by virtue of (*inter alia*) the patentability of Claims 1, 100, and 111, from which they depend.

Referring next to independent Claim 34, the Office Action admits that “Hamel does not specifically teach of [sic] associating comment by associating a selected audio file”. Office Action, p. 5, lines 7 - 8. Applicants respectfully submit that this is not the claim language of Claim 34.

Furthermore, Applicants respectfully disagree with the assertion on p. 5, lines 4 - 6 of the Office Action that Hamel teaches “... inserting audio comments between individual segments at corresponding message segment bullets”. Hamel is clear that his acoustic bullets are “a DTMF signal of 770 Hz by 1447 Hz for 500 milliseconds”. See col. 3, lines 44 - 47 and col. 3, lines 58 - 59. Clearly, this is not an “audio comment” as suggested by the Office Action.

Applicants have amended Claim 34 herein to specify that the selected audio file is selected “from among a plurality of available audio files” (Claim 34, lines 6 - 7). It is clear that the 770 Hz by 1447 Hz DTMF signal generated in response to Hamel’s user pressing the six key on his or her phone (see col. 3, lines 43 - 44) is not an “audio file [selected] from among a plurality of available audio files”, in contrast to the limitations specified in Applicants’ Claim 34. Instead, Hamel’s user



either presses the six key to signal an acoustic bullet, or does not; there is no teaching, nor any suggestion, in Hamel that the user has any other imbeddable sounds (or “audio files”, to use Applicants’ claim language) from which to select.

Applicants also reiterate the above discussion regarding prohibited hindsight reconstruction, as this argument applies equally to independent Claim 34.

With reference to the cited portions of Roth (Office Action, p. 5, lines 11 - 12), refer to the discussion of Claim 1, above, where each of these citations has been discussed in detail to demonstrate that Applicants’ claimed invention is not taught or suggested therein. To briefly summarize those discussions in terms of the specified limitations of Claim 34,

- col. 6, lines 22 - 56 state that a user chooses background sounds as part of changing his or her “personal options”, and **Fig. 3** clearly shows that these background sounds are not part of the process of creating a new multi-mail message (and furthermore, the “audio file” specified in Claim 34 is not a background sound; instead, it is inserted between message segments; see Claim 34, lines 6 - 11);
- col. 8, line 11 - col. 9, line 3 discusses selecting a sound effect for applying to a multi-mail message, and as stated by Roth in col. 3, lines 15 - 16, “A multi-mail message is an email message ...” (emphasis added). Applicants respectfully submit that one of skill in the art would not be motivated to attempt combining Roth’s email message techniques with Hamel’s telephone system, particularly in view of

Hamel's teaching that acoustic bullets are represented by a particular 500-millisecond DTMF tone that is generated responsive to pressing the six key on a telephone;

- col. 9, line 58 - col. 10, line 48 pertains to creating the voice portion of a voicemail message, and in particular, states that the user may "enter text via user interface device **120**" (col. 10, lines 31 - 32) or may "submit a spoken message by telephone" (col. 10, lines 39 - 40). For the latter case, Roth states that "Next, central controller translates the sound [i.e., the spoken message] to text ..." (col. 10, lines 43 - 44). Applicants respectfully submit that this is distinct from "selecting, by the caller using the telephone device, an audio file from among a plurality of available audio files ..." (Claim 34, lines 6 - 7);
- col. 12, lines 14 - 43 provide further detail of how the user speaks an audio component that is going to be converted to text, as discussed above, and Applicants respectfully submit that this is distinct "selecting, by the caller using the telephone device, an audio file from among a plurality of available audio files ..." (Claim 34, lines 6 - 7). Furthermore, Applicants respectfully submit that this text from col. 12, lines 14 - 43 is discussing the voice message itself and not (as claimed in Claim 34 on lines 6 - 11) an audio file to be inserted into a voice mail message.

In view of the above, Applicants respectfully submit that Hamel and/or Roth fail to teach, or suggest, all of the limitations specified in independent Claim 34. Independent Claim 114

(discussed in the Office Action on p. 6, lines 18 - 21) specifies limitations which are analogous to those of Claim 34, and the arguments presented above therefore apply equally to Claim 114. Claims 34 and 114 are therefore deemed patentable over these references. Dependent Claims 37 and 115 are therefore deemed patentable by virtue of (*inter alia*) the patentability of Claims 34 and 114, from which they depend.

In view of the above, the Examiner is respectfully requested to withdraw the §103 rejection of Claims 1, 9, 15, 17 - 18, 20, 22, 28, 34, 37, 99 - 102, 105 - 109, and 111 - 115.

II. Second Rejection Under 35 U. S. C. §103(a)

Paragraph 6 of the Office Action states that Claims 11 and 103 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hamel in view of Roth and further in view of U. S. Patent 6,125,175 to Goldberg. This rejection is respectfully traversed.

Applicants have demonstrated, above, that independent Claims 1 and 100 are patentable over Hamel and Roth. Accordingly, dependent Claims 11 and 103, which depend therefrom, are deemed patentable by virtue of (at least) the patentability of the independent claims. The Examiner is therefore respectfully requested to withdraw the §103 rejection of Claims 11 and 103.

III. Third Rejection Under 35 U. S. C. §103(a)

Paragraph 7 of the Office Action states that Claims 14 and 104 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hamel in view of Roth and further in view of U. S.

Patent 6,634,992 B1 to Ogawa. This rejection is respectfully traversed.

Applicants have demonstrated, above, that independent Claims 1 and 100 are patentable over Hamel and Roth. Accordingly, dependent Claims 14 and 104, which depend therefrom, are deemed patentable by virtue of (at least) the patentability of the independent claims. The Examiner is therefore respectfully requested to withdraw the §103 rejection of Claims 14 and 104.

IV. Fourth Rejection Under 35 U. S. C. §103(a)

Paragraph 8 of the Office Action states that Claim 21 is rejected under 35 U.S.C. §103(a) as being unpatentable over Hamel in view of Roth and further in view of Newton's Telecom Dictionary. This rejection is respectfully traversed.

Applicants have demonstrated, above, that independent Claim 1 is patentable over Hamel and Roth. Accordingly, dependent Claim 21, which depends therefrom, is deemed patentable by virtue of (at least) the patentability of the independent claim. The Examiner is therefore respectfully requested to withdraw the §103 rejection of Claim 21.

V. Fifth Rejection Under 35 U. S. C. §103(a)

Paragraph 9 of the Office Action states that Claims 23 - 24 and 110 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hamel in view of Roth and further in view of U. S. Patent Publication 2002/0082838 A1 to Hinde. This rejection is respectfully traversed.

Applicants have demonstrated, above, that independent Claims 1 and 100 are patentable over Hamel and Roth. Accordingly, dependent Claims 23 - 24 and 110, which depend therefrom, are deemed patentable by virtue of (at least) the patentability of the independent claims. The Examiner is therefore respectfully requested to withdraw the §103 rejection of Claims 23 - 24 and 110.

VI. Sixth Rejection Under 35 U. S. C. §103(a)

Paragraph 10 of the Office Action states that Claim 90 is rejected under 35 U.S.C. §103(a) as being unpatentable over Hamel in view of Roth and further in view of U. S. Patent 5,850,431 to Satou. This rejection is respectfully traversed.

Applicants have demonstrated, above, that independent Claim 1 is patentable over Hamel and Roth. Accordingly, dependent Claim 90, which depends therefrom, is deemed patentable by virtue of (at least) the patentability of the independent claim. The Examiner is therefore respectfully requested to withdraw the §103 rejection of Claim 90.

VII. Conclusion

Applicants respectfully request reconsideration of the pending rejected claims, withdrawal of all presently outstanding rejections, and allowance of all remaining claims at an early date.

Respectfully submitted,

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